

REMARKS

Applicant appreciates the Examiner's attention to this application.

The Office Action objects to claims 2-7, 9-10, 12-17, and 19-21 due to alleged informalities. The Office Action rejects claims 8-17 under 35 U.S.C. § 101 as being directed to unpatentable subject matter. The Office Action rejects claims 1-3 and 18-19 under 35 U.S.C. § 102(a) as being anticipated by European patent application no. 02354066.9 to Paul Neuman et al. (hereinafter "Neuman"). The Office Action rejects claims 4 and 20 as being unpatentable over Neuman in view of U.S. patent no. 6,823,451 to Dale E. Gulick et al. (hereinafter "Gulik"). The Office Action indicates that claims 5-7 and 21 would be allowable if rewritten into independent form.

The Office Action also indicates that "should claims 8-17 be amended to overcome the rejection under 35 U.S.C. § 101, the prior art used in the rejections of the other claims might be used to reject the subject matter in the amended claims" (emphasis added).

With regard to some or all of the above objections and rejections, Applicant respectfully traverses.

The Alleged Informalities in Certain Claims:

The Office Action objects to claims 2-7, 9-10, 12-17, and 19-21 due to alleged informalities. Specifically, the Office Action asserts that those claims must start with the article "the" instead of the article "a." However, as pointed out in Applicant's response to the first Office Action, no legal authority has been cited to support this objection. Applicant therefore cannot determine why the Office Action deems such changes necessary, which makes it difficult or impossible for Applicant to address the objections on their merits (if any).

Since the objections have nothing to do with whether or not the claims describe patentable subject matter, but instead pertain to a mere formality, to avoid additional delay and expense, this response amends claims 2-7, 9-10, 12, 14-17, and 19-21 to recite "The method," "The apparatus," and "The processing system,"

as suggested by the Office Action. (Applicant assumes that the Office Action did not intend to object to claim 13, since that claim is independent, unlike the others referenced above.)

The Rejections under 35 U.S.C. § 101:

The Office Action rejects claims 8-17 under 35 U.S.C. § 101 as being directed to unpatentable subject matter. Specifically, the Office Action asserts that those claims involve a machine-accessible medium that is described in the specification as including allegedly non-statutory "communication media." The Office Action also advises Applicant to amend the claims to recite "storage media." This response amends claims 8, 11 and 13 in accordance with the advice from the Office Action. Since the other claims depend ultimately from claim 1, claim 11, or claim 13, these rejections should be withdrawn.

The Rejections under 35 U.S.C. § 102(a):

The Office Action rejects claims 1-3 and 18-19 under 35 U.S.C. § 102(a) as being anticipated by Neuman. Under Section 102(a), Applicant is entitled to a patent unless "the invention was ... described in a printed publication in ... a foreign country, before the invention thereof" by Applicant. The publication date of Neuman was October 29, 2003 (hereinafter the "Reference Date").

As indicated in the response to the first Office Action, the present invention was conceived before that Reference Date and thereafter filed as a patent application with due diligence. Furthermore, a declaration and associated evidence providing additional facts concerning the date of conception and due diligence were filed with the response to the first Office Action. The declaration and evidence show that the invention was not described in a printed publication in a foreign country, before the invention thereof by Applicant.

The final Office Action asserts that the declaration and evidence which Applicant has already submitted are "insufficient to establish conception of the invention" prior to the Reference Date. However, the Office Action does not indicate how the evidence in this case is "insufficient." The Office Action explains certain

requirements for effective evidence, but does not indicate how, or even whether, the evidence submitted in this case meets or does not meet those requirements.

The Office Action seems to focus on requirements for the evidence to include facts which show conception of the invention prior to the Reference Date, and more than just a vague idea about how to solve a problem.

However, the evidence that Applicant submitted was a completed Invention Disclosure Form (IDF) that provides specific details on means for implementing the invention, and how those means interact, in an example embodiment. For instance, the IDF describes components such as a "runtime monitor," SMRAM, a "runtime monitor SMI/PMI handler" which runs in the SMRAM, reserved memory, and a "firmware late-init core" residing in the reserved memory. Moreover, the IDF provides two detailed flowcharts explaining how those components interact.

Claim 1 of the present application recites a method comprising:

- initializing a processing system according to predetermined basic input/output system (BIOS) settings for the processing system;
- booting an operating system (OS) on the processing system; and
- providing a virtual runtime interface that allows a user to modify the BIOS settings for the processing system after the OS has been booted.

The IDF provides more than ample evidence to show that the inventors conceived of that invention before the Reference Date. For at least the foregoing reasons, Applicant traverses the assertion that the declaration and IDF are "insufficient to establish conception of the invention" prior to the Reference Date.

For at least the foregoing reasons, the rejections under 35 U.S.C. § 102(a) should be withdrawn.

The Rejections under 35 U.S.C. § 103(a):

The Office Action rejects claims 4 and 20 as being unpatentable over Neuman in view of U.S. patent no. 6,823,451 to Dale E. Gulick et al. (hereinafter "Gulik"). However, as indicated above, Nueman does not constitute prior art, in light of the Declaration and IDF submitted earlier. For at least the foregoing reason, the rejections under 35 USC § 103(a) should be withdrawn.

CONCLUSION

For all of the foregoing reasons, reconsideration of the present application is respectfully requested.

If the Examiner has any questions, the Examiner is invited to contact the undersigned at (512) 732-3927.

Respectfully submitted,

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/ Michael R. Barre /
Michael R. Barré
Patent Attorney
Intel Americas, Inc.
Registration No. 44,023
(512) 732-3927

c/o Blakely, Sokoloff, Taylor &
Zafman, LLP
12400 Wilshire Blvd.
Seventh Floor
Los Angeles, CA 90025-1026